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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,635	12/17/2003	Satoshi Okamoto	Q78955	4743

7590 04/19/2005

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,635

Applicant(s)

OKAMOTO ET AL.

Examiner

Nathan M. Nutter

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Re-assignment of Application

This application has been re-assigned to Examiner Nathan M. Nutter, Art Unit 1711. Examiner Nutter may be reached at telephone number 571-272-1076 for inquiry concerning this re-assignment.

Response to Amendment

In response to the amendment and Applicants' Response, the rejection of claims 1-11,13 -17,19 - 21 under 35 U.S.C. 102(b) as being anticipated by Hosaki et al is hereby expressly withdrawn.

Further, the objection to claims 12 and 18 "as being dependent upon a rejected base claim, but... allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," is hereby vacated in view of the following rejections.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis in claim 22, from which claim 23 depends, for the term "dielectric substance paste." As such, this claim is deemed to be vague and confusing.

Claim Objections

Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 23, drawn to a "dielectric substance paste," depends improperly from claim 22, drawn to a laminated article.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/799,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is

drawn to a resin composition which may embrace the resin, film, laminate and the process of making the film as claimed herein. Further, the manipulation of solvent in the composition would determine whether a liquid or a paste composition would be produced.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/763,385. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a resin composition which may embrace the resin, film, laminate and the process of making the film as claimed herein. Further, the manipulation of solvent in the composition would determine whether a liquid or a paste composition would be produced.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/647,379. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because the copending application is drawn to a resin composition which may embrace the resin, film, laminate and the process of making the film as claimed herein. Further, the manipulation of solvent in the composition would determine whether a liquid or a paste composition would be produced.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Katagiri et al (US 2004/0044171 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ueno et al (US 2005/0054811 A1), newly cited.

The U.S. Patent Application Publication to Ueno et al teaches the production of a liquid crystal polyester resin that may comprise the identical monomers, present in identical proportions and used to make a film. Note paragraph [0018] for the aromatic hydroxycarboxylic acids, including 2-hydroxy-3-naphthoic acid, as recited in claim 1. Note paragraph [0019] for the aromatic dicarboxylic acids employed, including "terephthalic acid, isophthalic acid, (and) 2,6-naphthalene dicarboxylic acid," as recited in claims 3, 4 and 5. Note paragraph [0020] for the aromatic diols employed, including the 4,4'-dihydroxybiphenyl, as recited in claim 2. Note paragraph [0002] for the production of the film.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kometani et al, newly cited.

The reference to Kometani et al teaches the production of a liquid crystal polyester resin that may comprise the identical monomers, present in identical proportions and used to make a film. Note column 4 (lines 11-19) for the aromatic hydroxycarboxylic acids, including 2-hydroxy-3-naphthoic acid, as recited in claim 1. Note column 2 (lines 20-32) for the aromatic dicarboxylic acids employed, including "terephthalic acid, isophthalic acid, (and) 2,6-naphthalene dicarboxylic acid," as recited in claims 3, 4 and 5. Note column 4 (lines 20-28) for the aromatic diols employed, including the 4,4'-dihydroxybiphenyl, as recited in claim 2. Note column 2 (lines 12-25) for the production of the film.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Suenaga et al, newly cited.

The reference to Suenaga et al teaches the production of a liquid crystal polyester resin that may comprise the identical monomers, present in identical proportions. Note column 3 (lines 4-18) for the aromatic hydroxycarboxylic acids, including 2-hydroxy-3-naphthoic acid, as recited in claim 1. Note column 3 (lines 20-32) for the aromatic dicarboxylic acids employed, including "terephthalic acid, isophthalic acid, (and) 2,6-naphthalene dicarboxylic acid," as recited in claims 3, 4 and 5. Note column 3 (lines 33-39) for the aromatic diols employed, including the 4,4'-dihydroxybiphenyl, as recited in claim 2.

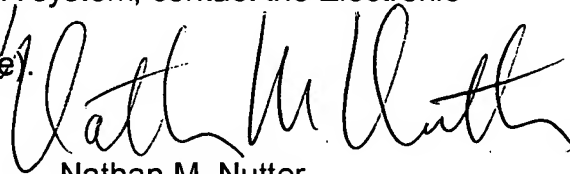
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Due to the new grounds of rejections, this Action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

15 April 2005